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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/382,458	08/25/1999	YOSHIHIRO WATANABE	21.1918	5255

21171 7590 02/11/2004

STAAS & HALSEY LLP  
SUITE 700  
1201 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER
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PIZARRO, RICARDO M

ART UNIT	PAPER NUMBER
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2661

13

DATE MAILED: 02/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/382,458

**Applicant(s)**

WATANABE, YOSHIHIRO

**Examiner**

Ricardo M. Pizarro

**Art Unit**

2661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17, 20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14, 15 and 17 is/are allowed.
- 6) ☒ Claim(s) 16 and 20-22 is/are rejected.
- 7) ☒ Claim(s) 1-13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/9/04 has been entered.

#### ***Claim Objections***

2. Claims 1-13 and 16 are objected to because of the following informalities and it is suggested to applicant:

In claim 1 line 6 , claim 7 line 6 and claim 9 line 6 insert "of two or more paths" after -path-.

In claim 7 line 6 replace "the" with -a-.

In claim 13 line 9 replace "the" with -a-, in line 10 insert "of paths" after -plurality-.

In claim 16 line 5 replace the second occurrence of "the" with -a-.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who

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has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 21-22 are rejected under 35 U.S.C. 102(e) as being anticipated by admitted prior art.

Admitted prior art ( Fig. 1) discloses a method of using a switching system ( switching system 30) to obtain from a subscriber ( Subscribers 1,B and C in Fig. 1) of a service provider, communication path that together provide a given session of a type of an application service (VOD service) provided by one or more servers ( Server 35 in Fig. 1) , where the type of application service is predefined to require multiple paths( e.g., voice channel, image channel), the method comprising when initiating the e given session transmitting from a subscriber terminal a request ( requests sent by subscribers 31 to server, 1 page 2 line 12) for a first communication path corresponding to a first of the paths ( i.e. image channel ) that are predefined to be required to provide the type of application service of the given session and receiving the request at a switching system ( Switching system 30 in Fig. 1) and in response based on the request securing a second communication path for the given session ) dedicated channels to provide service. I.e. secured channels, page 2 line 16) where the second communication path corresponds to a second of the paths that are predefined to be required to

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provide the type of application service to the given session, as in claim 21; wherein the application service comprises a video on demand service ( VOD service provide by service provider, page 2 line 11), wherein the predefined paths comprise at least a media path and a control path ( voice, image and control paths in Fig. 1), as in claim 22.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 16 and, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi in view of admitted prior art.

Takahashi ( US No. 6, 282,197) discloses an ATM switching apparatus, comprising: sending a request message from the subscriber to the switching system to set in order of large bandwidth to small bandwidth the various bandwidth which correspond to multiple paths required to provide the service (e.g. QOS, Fig. 9, col 16 lines 66-67, col 17 lines 1-9) , securing the bandwidth required between the service provider and the subscriber in order of large bandwidth to small bandwidth in response to the request message (e.g. QOS, Fig. 9, col 16 lines 66-67, col 17 lines 1-9), as in claim 16.

Takahashi did not specifically disclose a channel type of each path being different as in claims 16 and 20.

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Admitted prior art ( Fig. 2) discloses a conventional switching system 30. In Fig.2 subscriber A,B,C and D, switching system 30 and server 35 are indicated by vertical lines. When subscriber A sends a setup message for the control channel , system 30 secures the control channel bandwidth and sends message to the server. Likewise subscriber B,C and D proceed in the same manner to set said control channel. Server 35 sends path completion messages to all subscribers. Subscriber A,B,C and D proceed in the same manner to set the voice channel and image channel , as in claims 16 and 20.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to provide a channel type of each path being different as in the prior art to the unit disclosed by Takahashi with the motivation of obtaining a switching apparatus capable of decreasing the probability of a connection establishing a request being rejected.

### ***Allowable Subject Matter***

7. Claim 14-15 , 17 are allowed.
8. Claims 1-13 would be allowable if rewritten to overcome objection to claims under 37 CFR 1.75.

### ***Conclusion***

**9. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

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(703) 872-9314

(for formal communications intended for entry, for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Ricardo Pizarro** whose telephone number is (703) 305-1121. The examiner can normally be reached on Monday-Friday from 9:00 AM to 5:30 PM. The fax number for this Group is (703) 872-9314.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Douglas Olms**, can be reached on (703) 305-4703.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

1/29/2004

*Ricardo M. Pizarro*



DOUGLAS OLMS  
SUPERVISORY PATENT EXAMINER  
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